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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,680	03/16/2004	Hyun Woo Song	P69577US0	1642
136	7590	03/31/2005	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			ANYA, IGWE U	
			ART UNIT	PAPER NUMBER
			2891	

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,680

Applicant(s)

SONG ET AL.

Examiner

Igwe U. Anya

Art Unit

2891

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Skotnicki et al. (US Patent 6713356).

3. Skotnicki et al. teach a method for fabricating a semiconductor optical device, comprising the steps of:

alternately stacking two or more types of semiconductor layers having different etch rates on a semiconductor substrate (fig. 2a elements 14, 16 {Si-Ge}, & elements 15, 17 {Si});

patterning the stacked semiconductor layers (fig. 2b) using a given mask (19);

forming a mesa structure (fig. 2c) to etch selectively at least one type of semiconductor layers (16) resulting in an air-gap structure, wherein the rest of the semiconductor layers compose the mesa structure;

depositing a material (20) having a good heat transfer property so that the air gap is buried; and

wherein the material having the good heat transfer property is one of Al₂O₃, ZnO, MgO, TiO₂, Ta₂O₅, ZrO₂, HfO₂, SiO₂, Si₃N₄, AlN, and AlON, or a combination thereof (col. 2 lines 37 – 50).

4. Regarding claim 4 the examiner takes official notice that Silicon (Si), and silicon germanium (Si-Ge) are materials that can be grown by a crystalline growth on a semiconductor substrate. Applicant is further referred to Furukawa (US Patent 6555891).

5. Regarding claims 2 and 3 to be entitled to weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense, and not the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

6. The recitation "optical device" has not been given patentable weight in view of (Optical MOSFETs for example Tamura et al. JP Patent 2001135850), because a preamble is denied the effect of a limitation where the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa V. Robie, 88 USPQ 478 (CCPA 1951).

7. Claims 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

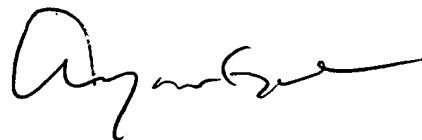
8. Prior art made of record and not relied upon, considered pertinent to applicant's disclosure include Song et al. (USPAB 2004/0099857), Spahn et al. (US Patent 6577785), Tayebati (US Patent 5739945), and Tayebati (US Patent 6324192).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igwe U. Anya whose telephone number is (571) 272-1887. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William B. Baumeister can be reached on (571) 272-1722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igwe U. Anya
Examiner
Art Unit 2891



IA

March 28, 2005